REMARKS

This Response is submitted in reply to the Final Office Action dated October 27, 2010. Claims 37 to 48 are pending in the present application. Claims 1 to 36 stand previously cancelled. Claims 37, 41 and 45 are hereby amended. No new matter has been added by such amendments. Support for the amendments can be found in the Specification filed on April 21, 2006, on at least page 10, line 16 to page 11, line 16. Claims 37, 41 and 45 are in independent form. A Supplemental Information Disclosure Statement is submitted with this Response. Please charge Deposit Account No. 02-1818 for all payments due in connection with this Request for Continued Examination and this Response.

As noted above, Applicant has filed a Request for Continued Examination with this Response. Accordingly, Applicant requests that the Examiner allow the application or provide an Office Action which identifies ". . . any claims which he or she judges, as presently recited, to be allowable and/or . . . suggest any way in which he or she considers that rejected claims may be amended to make them allowable" in accordance with §707.07(d) of the MPEP.

Page 2 of the Office Action stated:

> Applicant requests that the Examiner consider (a) Photoshop 6.0 Technical bible, Softbank Publishing Inc., 1st edition, 25 January, 2001, pp. 67- 68; (b) Totte Karaga Shobu!" no Digital Camera Katsuyo technique," Nikkei Zero-One, NlKKEI HOME PUBLISHING, INC., No. 52, 01 September, 2000, pp. 44-57; and (c) "Digital Camera Gazo o Online Print," Nikkei Personal Computing, Nikkei Business Publications, Inc., No. 409, 13 May, 2002, pp. 98-105. See Amendment, pgs. 8-10.

> Specifically, in the Amendment, on pgs. 8-10, Applicant puts forth arguments as to why the above referenced non-patent literature should be considered.

> The Examiner has considered the arguments carefully, and agrees with Applicant's arguments.

> Accordingly, Applicant is advised to file an IDS citing the above referenced non-patent literature. At that time the Examiner will consider the references.

In view thereof, Applicant has included a Supplemental Information Disclose Statement with this Response. Applicant respectfully requests that the Examiner consider the references cited in the Supplemental Information Disclosure Statement with this Response.

The Office Action rejected Claims 37 to 48 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application No. 2001/0053247 to Sowinski et al ("Sowinski") in view of U.S. Patent No. 7,236,960 to Manico et al. ("Manico"). Applicant respectfully disagrees with these rejections. Nonetheless, to advance the prosecution of the present application, Applicant has amended certain of the claims.

1.   The Office Action Failed to Provide an Explicit, Cogent Reason Why it would be Obvious to Modify Sowinski with Manico

In the Office Action, the Examiner selected Sowinski as the base reference.

Sowinski discloses a plurality of picture appearance choices from a color photographic recording material intended for scanning. The Abstract of Sowinski discloses:

> A system and method of offering photofinishing services involves receiving an exposed photographic film from a customer; developing and scanning the film to produce a digital image; displaying examples of a plurality of looks on a color display medium to a customer; receiving a selection of a preferred look from the customer; and applying the selected look to the digital image to produce a processed digital image having the preferred look.

Recognizing the deficiencies of Sowinski, the Office Action acknowledged that:

> [i]t does not appear that Sowinski discloses enabling a user to select an image stored in t eh user terminal; and in response to the image stored in the user terminal being selected:
>
> (i) transmitting the image stored in the user terminal to the server;
>
> (ii) causing the server to generate a plurality of second image-processing-mode-selection images based on said transmitted image, each of said second image-processing-mode-selection images being subjected to different image processes;
>
> (iii) causing the display device to display each of said generated second image-processing-mode-selection images;
>
> (iv) enabling the user to select one of the displayed second image-processing-mode-selection images;
>
> (v) in response to one of the displayed second image-processing-mode-selection images being selected, cause the server to store a second image processing mode based on said selection of the displayed second image-processing-mode-selection image; and

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(vi) causing the printer system to execute print processing based on the second image processing mode stored by said server.

The Office Action turned to Manico for these elements.

Manico discloses software and a system for customizing a presentation of digital images. The Abstract of Manico discloses:

> [a] method for customizing a presentation of a set of digital images provided by a user is disclosed, comprising the steps of selecting an initial presentation format criteria for the set of digital images by the user; analyzing the digital images for additional information; providing to the user a first portable electronic storage medium having the set of digital images stored thereon, the images capable of being presented to the user on a display device in accordance with a first presentation format based upon the initial selected presentation format criteria and the analysis of the additional information; and providing a software program to the user enabling the user to select additional presentation format criteria.

The Office Action concluded that:

> [i]t would have been obvious to one of ordinary skill in the art at the time of the invention user the teachings of Manico for using a users own image for processing presentation with the teachings of Sowinski in order to increase the amount of image available to a user. This would increase user satisfaction.

To establish a *prima facie* case of obviousness, the Office Action has an obligation to construe the scope of the prior art, identify the differences between the claims and the prior art, and determine the level of skill in the pertinent art at the time of the invention. The Office Action must then provide: (1) an explicit, cogent reason based on the foregoing why it would be obvious to modify the prior art to arrive at the claimed invention; (2) a reasonable expectation of success; and (3) a teaching or suggestion of all claimed features. See MPEP §§ 706.02(j) and 2143.

As described above, after acknowledging that Sowinski:

> does not appear that Sowinski discloses enabling a user to select an image stored in t eh user terminal; and in response to the image stored in the user terminal being selected:
>
> (i) transmitting the image stored in the user terminal to the server;
>
> (ii) causing the server to generate a plurality of second image-processing-mode-selection images based on said transmitted image, each of said second image-processing-mode-selection images being subjected to different image processes;

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(iii) causing the display device to display each of said generated second image-processing-mode-selection images;

(iv) enabling the user to select one of the displayed second image-processing-mode-selection images;

(v) in response to one of the displayed second image-processing-mode-selection images being selected, cause the server to store a second image processing mode based on said selection of the displayed second image-processing-mode-selection image; and

(vi) causing the printer system to execute print processing based on the second image processing mode stored by said server.

the Office Action concluded that:

> [i]t would have been obvious to one of ordinary skill in the art at the time of the invention user the teachings of Manico for using a users own image for processing presentation with the teachings of Sowinski in order to increase the amount of image available to a user. This would increase user satisfaction.

The Office Action's reasoning is not an explicit, cogent reason why it would be obvious to modify Sowinski with Manico to arrive at the claimed invention. Rather, such a improper generic statement related to increasing the amount of images available provides no basis or reason for why one of ordinary skill in the art would or would not combine Sowinski with Manico. This generic reason of combining references to increase the amount of images available to a user results in nearly every reference in the printing industry being combinable with nearly every other reference in the printing industry. This is clearly not the case.

As reiterated by the United States Supreme Court in <u>KSR International Company v. Teleflex Inc., et al.</u>:

> rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.

In this case, the Office Action's reasoning consists of improper conclusory statements regarding increasing the amount of images available to a user. Such reasoning lacks the rational underpinning required to support any legal conclusion of obviousness. Accordingly, adding Sowinski with Manico under the guise of increasing the amount of images available is improper.

For this reason alone, the rejection of Claim 37 is improper and should be reversed.

Independent Claims 41 and 45 each include certain similar elements to independent Claim 37. For reasons similar to those discussed above with respect to independent Claim 37, the rejections of independent Claims 41 and 45 are improper and should be reversed.

2.   The Combination of Sowinski and Manico does <u>Not</u> an Image Which is (a) Stored in the User Terminal, (b) Selected by the User, and (c) Transmitted to the Server for Generating Second Image-Processing-Mode-Selection Images

The print-ordering system resulting from a combination of Sowinski and Manico would include an image provided by a user for presentation processing. (Manico, Abstract). It appears that the Office Action would interpret Manico's image provided by the user as the image stored in the user terminal of Claim 37. Applicant submits that Manico's image provided by the user is <u>not</u> transmitted to any servers which generate images based on Manico's image provided by the user.

That is, unlike the print-ordering system of Claim 37, the print-ordering system resulting from a combination of Sowinski and Manico does <u>not</u> disclose in response to the image stored in the user terminal being selected: (i) transmit the image stored in the user terminal to the server; (ii) cause the server to generate a plurality of second image-processing-mode-selection images based on said transmitted image, each of said second image-processing-mode-selection images being subjected to different image processes.

For at least this reason, it is respectfully submitted that independent Claim 37 is patentably distinguished over Sowinski and Manico and in condition for allowance. Dependent Claims 38 to 40 depend directly from amended independent Claim 37 and are also allowable for the reasons given with respect to Claim 37 and because of the additional features recited in these claims.

Independent Claims 41 and 45 each include certain similar elements to independent Claim 37. For reasons similar to those discussed above with respect to independent Claim 37, independent Claims 41 and 45 (and dependent Claims 42 to 44 and 46 to 48) are patentably distinguished over Sowinski and Manico and in condition for allowance.

3. Amendments

Despite the foregoing traversal, to advance the prosecution of the present application, Applicant has amended independent Claim 37 in view of the Office Action. Specifically, page 7 of the Office Action stated:

> [w]hile it may be true that Sowinski selects one of his previous images, this image is a sample image that has been stored, as the claims require. . . . Moreover, Applicant's claims do not require that the sample image be an image that is not owned by a user.

Amended independent 37 now includes, "(a) enable a user to select one of: (i) a predetermined sample image stored in the image database, the predetermined sample image being not owned by the user; or (ii) an image stored in the user terminal." Applicant submits that the print-ordering system resulting from a combination of Sowinski and Manico does not disclose the foregoing elements.

For at least this reason, it is respectfully submitted that independent Claim 37 is patentably distinguished over Sowinski and Manico and in condition for allowance. Dependent Claims 38 to 40 depend directly from amended independent Claim 37 and are also allowable for the reasons given with respect to Claim 37 and because of the additional features recited in these claims.
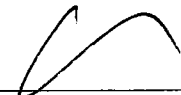
Independent Claims 41 and 45 each include certain similar elements to independent Claim 37. For reasons similar to those discussed above with respect to independent Claim 37, independent Claims 41 and 45 (and dependent Claims 42 to 44 and 46 to 48) are patentably distinguished over Sowinski and Manico and in condition for allowance.

An earnest endeavor has been made to place this application in condition for formal allowance, and allowance is courteously solicited. If the Examiner has any questions regarding this Response, Applicant respectfully requests that the Examiner contact the undersigned

Respectfully submitted,

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Dated: January 10, 2010